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1618



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/253,973	06/03/1994	WILLIAM MCBRIDE	DITI109	5419

7590 10/14/2005

PATRICIA A. MCDANIELS  
DIATIDE, INC.  
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LONDONDERRY, NH 03053

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**OCT 31 2005**

EXAMINER
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HARTLEY, MICHAEL G

ART UNIT	PAPER NUMBER
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1618

DATE MAILED: 10/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

08/253,973

Applicant(s)

MCBRIDE ET AL.

Examiner

Michael G. Hartley

Art Unit

1618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2-8 and 10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2, 3, 7 and 10 is/are rejected.
- 7) ☒ Claim(s) 4-6 and 8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date here to
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

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Art Unit: 1618

### ***Interference***

Interference No. 104,789 has been terminated by a decision adverse to applicant. *Ex parte* prosecution is resumed.

An adverse judgment against claims 2, 3, 7 and 10 has been entered by the Board. Claims 2, 3, 7 and 10 stand(s) finally disposed of for failure to reply to or appeal from the examiner's rejection of such claim(s) presented for interference within the time for appeal or civil action specified in 37 CFR 1.304. Adverse judgment against a claim is a final action of the Office requiring no further action by the Office to dispose of the claim permanently. See 37 CFR 41.127(a)(2).

### ***Claim Objections***

Claims 4-6 and 8 are objected to as being dependent upon a rejected base claim, but may be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**NOTE:** the rewriting of the claims in independent form may add confusion to the claims for claims 4-6 and 8. This is because claims 4 and 8 are not within the scope of their respective base claims. For example, claim 4 encompasses a formula of claim 2 wherein **one** R group is a Z-L-moiety and another R group is a COX group, thus two R groups are substituted with moieties including targeting agents and possibly amino acids. However, claim 2 does not encompass such a formula because it states "**one** R or R' is L" and therefore only **one** R or R' may be substituted in manner to include targeting moieties and amino acids. Thus, if one R group is the Z-L moiety in claim 4, there is no possible substitution on the formula of claim 2 that would allow for the COX moiety. For the same reason, the only one substitution, the compounds of claim 10 do not appear to be within the scope of claim 2. It appears that this may be rectified by merely amending claim 4 to be an independent claim, making sure all variables in the formula are defined and for claim 4, stating "A reagent comprising a targeting moiety covalently linked to a metal chelator having the formula....(the rest of claim 4). However, for claim 8, no clear resolution is seen because this claim cannot be merely made into independent form, as it would be unclear where the

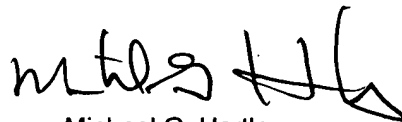
Art Unit: 1618

targeting agent would be as a substitution, thus, it may be broader than originally claimed and raise new matter issues. The possibility of amending this claim to be dependent on claim 4 exists, only if it can be clearly shown that the chelators in claim 8 are within the scope of claim 4.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael G. Hartley whose telephone number is (571) 272-0616. The examiner can normally be reached on M-Tu and Th-F, 7:30-4, Telework on Wed..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'mthls' followed by a stylized flourish.

Michael G. Hartley  
Primary Examiner  
Art Unit 1618

10/7/2005

<b>Examiner-Initiated Interview Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	08/253,973	MCBRIDE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Michael G. Hartley	1618	

**All Participants:**
**Status of Application:** \_\_\_\_\_

 (1) Michael G. Hartley.

(3) \_\_\_\_\_

 (2) Fred Rabin (Appl. repr.).

(4) \_\_\_\_\_

**Date of Interview:** 3 October 2005
**Time:** \_\_\_\_\_

**Type of Interview:**

- ☒ Telephonic  
☐ Video Conference  
☐ Personal (Copy given to: ☐ Applicant ☐ Applicant's representative)

 Exhibit Shown or Demonstrated: ☐ Yes ☐ No

If Yes, provide a brief description:

**Part I.**

Rejection(s) discussed:

none

Claims discussed:

2-8 and 10

Prior art documents discussed:

none

**Part II.**
**SUBSTANCE OF INTERVIEW DESCRIBING THE GENERAL NATURE OF WHAT WAS DISCUSSED:**

*Discussed the adverse decision from the interference from the Board and informed appl. repr. that there are some claims still pending that did not correspond to the count. Appl. repr. suggested an office action to set forth the current status of these claims.*

**Part III.**

- ☐ It is not necessary for applicant to provide a separate record of the substance of the interview, since the interview directly resulted in the allowance of the application. The examiner will provide a written summary of the substance of the interview in the Notice of Allowability.  
☒ It is not necessary for applicant to provide a separate record of the substance of the interview, since the interview did not result in resolution of all issues. A brief summary by the examiner appears in Part II above.

  
 (Examiner/SPE Signature)

\_\_\_\_\_  
 (Applicant/Applicant's Representative Signature – if appropriate)

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